



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,779	10/29/2003	Fusao Tomita	506.40345VX1	6721
20457	7590	02/06/2006	EXAMINER	
ANTONELLI, TERRY, STOUT & KRAUS, LLP 1300 NORTH SEVENTEENTH STREET SUITE 1800 ARLINGTON, VA 22209-3873			STEADMAN, DAVID J	
			ART UNIT	PAPER NUMBER
			1656	

DATE MAILED: 02/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/694,779	Applicant(s) TOMITA ET AL.	
	Examiner David J. Steadman	Art Unit 1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-23,25-27,29 and 33-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 19-23,25-27,29 and 33-38 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/901,884
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

Art Unit: 1656

DETAILED ACTION

Status of the Application

[1] The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1656.

[2] Claims 19-23, 25-27, 29, and 33-38 are pending in the application.

[3] Applicant's preliminary amendment to the specification and claims, filed on 10/29/2003, is acknowledged.

[4] Receipt of an information disclosure statement (IDS), filed on 10/29/2003, is acknowledged.

[5] Applicant's claim to a prior application in the specification amendment filed on 10/29/2003 is acknowledged. Applicant is advised that the status of nonprovisional parent application(s) (whether patented or abandoned) should be included in a claim to a prior US application. If a parent application has become a patent, the expression "now Patent No. _____" should follow the filing date of the parent application. If a parent application has become abandoned, the expression "now abandoned" should follow the filing date of the parent application. In the response to this Office action, applicant should update the status of the prior US application.

Election/Restrictions

[6] Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claim(s) 19-23, 25-27, 29, and 33-38 drawn to an isolated DNA comprising SEQ ID NO:9, a recombinant DNA, a transformant, and a method for producing a protein complex, classified in class 435, subclass 232.2.
- II. Claim(s) 19-23, 25-27, 29, and 33-38 drawn to an isolated DNA comprising SEQ ID NO:10, a recombinant DNA, a transformant, and a method for producing a protein complex, classified in class 435, subclass 232.2.
- III. Claim(s) 19-23, 25-27, 29, and 33-38 drawn to an isolated DNA comprising SEQ ID NO:11, a recombinant DNA, a transformant, and a method for producing a protein complex, classified in class 435, subclass 232.2.
- IV. Claim(s) 19-23, 25-27, 29, and 33-38 drawn to an isolated DNA comprising SEQ ID NO:12, a recombinant DNA, a transformant, and a method for producing a protein complex, classified in class 435, subclass 232.2.
- V. Claim(s) 19-23, 25-27, 29, and 33-38 drawn to an isolated DNA comprising SEQ ID NO:13, a recombinant DNA, a transformant, and a method for producing a protein complex, classified in class 435, subclass 232.2.
- VI. Claim(s) 19-23, 25-27, 29, and 33-38 drawn to an isolated DNA comprising SEQ ID NO:14, a recombinant DNA, a transformant, and a

Art Unit: 1656

method for producing a protein complex, classified in class 435, subclass 232.2.

VII. Claim(s) 19-23, 25-27, 29, and 33-38 drawn to an isolated DNA comprising SEQ ID NO:15, a recombinant DNA, a transformant, and a method for producing a protein complex, classified in class 435, subclass 232.2.

VIII. Claim(s) 19-23, 25-27, 29, and 33-38 drawn to an isolated DNA comprising SEQ ID NO:16, a recombinant DNA, a transformant, and a method for producing a protein complex, classified in class 435, subclass 232.2.

[7] The inventions are distinct, each from the other because:

[8] Each of the nucleic acids of Groups I-VIII is structurally distinct and no single nucleic acid of Groups I-VIII would render any of the others obvious to one of ordinary skill in the art. Also, the nucleic acids of Groups I-VIII are related as subcombinations disclosed as usable together in a single combination. See particularly claims 20-21. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each of the nucleic acids of Groups I-VIII has separate utility such as being used as a hybridization probe or for encoding an individual polypeptide. See MPEP § 806.05(d). Further evidence of their separate utility is shown by claim 1, wherein the nucleic acids are claimed separately, *i.e.*, not as a combination.

[9] Claim 19 will be examined only to the extent the claim reads on the elected subject matter.

Art Unit: 1656

[10] MPEP § 803 sets forth two criteria for a proper restriction between patentably distinct inventions: (A) The inventions must be independent or distinct as claimed and (B) There must be a serious burden on the examiner. As shown above, the inventions of Groups I-VIII are independent or distinct, thus satisfying the first criterion for a proper restriction. MPEP § 803 additionally states that a serious burden on the examiner may be *prima facie* shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search. Each of the inventions of Groups I-VIII is structurally distinct encoding a structurally distinct ATPase subunit. Thus, each of the inventions requires a separate patent and non-patent literature and sequence search. As such, co-examination of the inventions of Groups I-VIII would place a serious burden on the examiner.

[11] Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

[12] Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David J. Steadman whose telephone number is 571-272-0942. The examiner can normally be reached on Mon to Thurs, 6:30 am to 5:00 pm.

Art Unit: 1656

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



David J. Steadman, Ph.D.
Primary Examiner
Art Unit 1656